

**REMARKS**

Claims 21-46 are rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement, the Examiner contending that Applicant's disclosure does disclose (sic):

“How the identification of the user is tracked for a return text communication from the receiver. For example, how plurality users with common name like John Smith is tracked so that the return text communication from the receiver is provided to the proper user.

How is the communication via physical mail exchanged between the user and the receiver.

How is the communication is exchanged between the user and the receiver when the contact information of the receiver is an account.”

Presumably, the Examiner intended to indicate that the above noted items do not find adequate support in the application as filed. In response, Applicant notes that Applicant discloses at paragraphs [0139]-[0152] that the invention can be implemented using a web-page mail server which operates by requiring the user to enter a user name and password. See, in particular, paragraph [0142]. Thus, it is clearly disclosed that a plurality of users with a common name can each be tracked because each has a unique user name/password combination. Regarding how the communication is exchanged via physical mail and between the user and the receiver, when the contact information of the receiver is an account, as noted in paragraph [0143], a web mail based mail server enables a user to establish one or more new independent email mailboxes, accounts, and addresses that are accessible from a web browser or other application running on any computer. Since such a web based mail server is, in effect, a database which stores in addition to messages to be delivered, address information, account information and the like. A person skilled in the art would readily recognize that any

information which is contained in a database can be printed and then physically mailed to an address stored in the database, i.e., an address associated with a particular account.

Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 USC 112, first paragraph, is requested.

Claims 21-46 are rejected under 35 USC 112, second paragraph. Since the Examiner makes no objection as to specific claim language, but rather seeks clarification regarding how certain claim elements may be implemented, this rejection also appears to be one, if made, should be based upon 35 USC 112, first paragraph, and not 35 USC 112, second paragraph. However, regarding the Examiner's various queries with respect to the rejection asserted under 35 USC 112, second paragraph, Applicant submits that the disclosure relating to the web based mail server at paragraphs [0139]-[0152] provides all information which would be required by a person having ordinary skill in the field of the invention to implement the invention and, to the extent relevant, to respond to the various queries made by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 USC 112, second paragraph, is requested.

Claims 21-46 are rejected under 35 USC 103 as being unpatentable over Cook in view of archived web pages of Keen.com (Keen).

In response, Applicant notes that during an interview with the Examiner on December 9, 2009, in response to a query regarding the publication date of the portions of Keen relied upon by the Examiner, the Examiner indicated that the publication date is contained in the URL address of the page. In this connection, the pages relied upon by the Examiner in Keen, namely pages 10-14 have as the date in the URL address February 29, 2000. Since the present application has a filing date of February 5, 2001, Keen can only be prior art under 35 USC

102(a). In this connection, as shown in the Declaration of the inventor submitted herewith to establish prior invention, Applicant conceived the invention prior to February 29, 2000, and worked diligently from that date until April 20, 2000 at which time the invention was reduced to practice as set forth in the Declaration as explained below. Since Keen is relied upon by the Examiner to support the rejection of all of the claims, since Keen is not prior art under 35 USC 102(a), and since the remaining cited reference Cook, does not provide teachings sufficient to render the invention not novel or not obvious, reconsideration and withdrawal of the rejection under 35 USC 103 is requested.

In the Action, at page 2, the Examiner refers to a prior Declaration under 37 CFR 1.131 filed June 4, 2009. In this connection, although the Declaration submitted herewith is similar to the previously filed Declaration, since the publication date of the portion of Keen which was relied upon by the Examiner was not clear, in the present Declaration, Applicant has included additional information showing that the invention was conceived on or about February 3, 2000, i.e., a few weeks before the February 29, 2000 publication date of Keen and between February and April 20, 2000, and Applicant conducted research and developed six web pages demonstrating reduction to practice of the invention on April 20, 2000. For reasons which are unclear, the Examiner contends that the concept of the limitations in the claimed invention of contact information of the receiver being hidden from a communication device, and identification information of a user being tracked from the text communication from the receiver” has not been shown to have been conceived prior to April 20, 2000. However, the pages shown in Exhibits 3-8 of the Declaration submitted herewith and in the previously filed Declaration clearly demonstrate that Applicant had possession of the concept. For example, in Exhibit 5, it is stated

“StarsBest.com is the first and only pay-per-e-mail service that allows fans for a fee to write a short e-mail to their favorite stars.

Stars get an opportunity to hear from fans and get paid for their effort. (Some stars may want to donate their proceeds to charity.) The amount of cash money a star can make is almost unlimited and all without having to do a great deal of work, without having to endorse a product, and without having to take any great risk. Starbest.com allows a star to keep in touch with the fans while cashing in on the fame.

Stars can pursue the e-mail at leisure. No personal response is required, expected, or necessary (although of course a response is always hoped for). At the star's option, Starsbest.com will provide an appropriate e-mail appreciation and recognition to the fan that the star has downloaded the e-mail.

Privacy and security are respected. Respond to the most interesting or enticing. Communicate with and see picture of your fans.”

Further, the downloads undertaken by Applicant beginning February 3, 2000 further demonstrate possession of the concept as of February 3, 2000 since the downloads obtained by Applicant beginning February 3, 2000 demonstrate a desire to determine how to implement these concepts as explained in detail in the Declaration at paragraphs 7-21 and associated exhibits. Thus, the inventor clearly had conceived of the invention with the claim limitations prior to Keen, i.e., prior to February 29, 2000. Further, the Declaration demonstrates reduction to practice of the invention by April 20, 2000, and diligence from prior to February 29, 2000 to reduction to practice on April 20, 2000. For example, the Declaration sets forth in detail at paragraphs 26-63 how the invention was reduced to practice by April 20, 2000 based on research conducted between February 3, 2000 and April 20, 2000.

Accordingly, reconsideration and withdrawal of the rejection under 35 USC 103(a) of Claims 21-46 is requested.

Accordingly, Applicant submits that the claims pending following entry of this amendment, namely Claims 21-46, are now in condition for allowance, which early action is requested.

If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

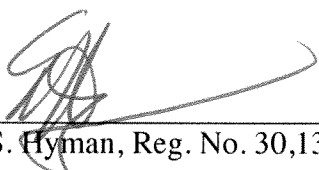
Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date:

12/22/09

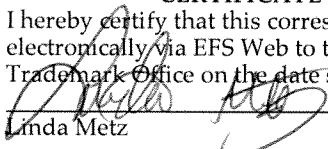
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I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on the date shown below.

  
Linda Metz

12/23/09